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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,516	12/30/1998	DENNIS M. O'CONNOR	INTL-0134-US	1486

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TIMOTHY N TROP
TROP PRUNER HU & MILES
8554 KATY FREEWAY SUITE 100
HOUSTON, TX 77024

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,516

Applicant(s)

O'CONNOR ET AL.

Examiner

HUY T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 28-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 11-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ottesen et al (5,778,135).

Regarding claims 11-15, Ottesen discloses a transmitter (Fig. 1) and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication (rating level) when a characteristic is detected; and a transmission device that transmits said video transmission together with said indication, wherein said transmission device is an over the air broadcast television transmitter (columns 5-6).

3. Claims 11 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Vogel (5446,488).

Regarding claims 11-12, 14-15, Vogel discloses a transmitter and a receiver (Fig. 1), the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication when a characteristic is detected (column 5, lines 30-50); and a transmission device that transmits said video transmission together

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with said indication, wherein said transmission device is an over the air broadcast television transmitter (column 5, lines 30-50) or cable television transmitter transmission and the receiver comprises a medium for storing instructions that cause a computer to

4. Claims 28-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (5,526,130).

Regarding claims 28-38, Kim teaches a method for transmission video signal from a broadcast station : transmitting a video transmission together with a coded command (start recording time and end recording time codes). The start recording time and end recording time in vertical blanking interval of the video transmission disclosed by Kim is considered as a command signal because they used for control the recording and en recording of a video recorder ((Figs 1,7,8, column 5, lines 55-60) column 6, lines 57 to column 7, line 10, column 8, line 65 to column 9,lines 25).

Kim further teaches a video receiver comprising: a first device to receive a transmitted video signal and recording command signal included in the vide signal; a second device coupled to said first device to detect a characteristic of the signal in the vertical blanking interval; and a video recorder that records said video signal in response to the detection of said characteristic . Further, Kim teaches the video transmission received from a broadcast station that include a replay such as prerecorded movies or a event being replay from a medium.

Applicant agues that " Kim teaches recording when the title of a program, which is input by a user matches the title of a program that is received in the broadcast schedule data. Column 5, lines 15-18; 55-67 through column 6, lines 1-4; 57-67. When

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the titles match, the information is stored and later compared again. If upon the second comparison the data is coincident, recording takes place. See, column 6, lines 57-67 through column 7, lines 1-11. The control signal to record comes from the comparator 90 and not the video transmission. *Id.* See also, Figure 1. Thus, Kim does not teach a command transmitted with a video transmission to begin recording or a command to begin recording a video transmission inserted within a video transmission.

In response the examiner disagrees. It is noted that the title or start time for a program that are inserted into the video signal is considered as a recording command since the recorder generating a starting of recording when the title or start time in the program is detected.

Applicant argues that "Claim 32 calls for monitoring an ongoing video transmission for a characteristic indicative of a replay, and upon detecting the characteristic, automatically recording the video transmission. Claim 36 calls for a second device coupled to a first device to detect a replay, and a video recorder that automatically records the video signal in response to the detection of the replay. Kim simply monitors for information regarding the title of a program. There is no monitoring for or detection of a replay. Nevertheless, there is no teaching of automatically recording a video transmission or video signal upon detection or in response to the detection of the replay. As such the rejecting of claims 32-38 should be withdrawn."

In response the examiner disagrees. It is noted that Kim teaches a receiver receiving broadcast television signal from a broadcast station that can be a

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prerecorded movies or events being a replay having associated title and start time indicating the replay .

5. Claims 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated Yamamura (5,784,522).

Regarding claims 32-38 , Yamamura discloses a method comprising: transmitting a video transmission together with a coded command to begin recording of the video transmission (Abstract, Fig. 1, column 8) and means of a video receiver for detecting the coded command signal in the video transmission to control a recorder for recording the video transmission (column 7, lines 20-25, column 10).

Regarding claim 31, Yamamura further teaches that the article further storing instructions that enable the system to automatically transmit a digital signal indicating that recording should begin (columns 3-4,8 and 10).

Further for claims 32- 36, it is noted that Yamamura teaches that the video transmission from the transmitter is reproduced from a recording medium and employ a human to monitor the video transmission captured in the field . Therefore the video transmission considered as a replay of prerecorded video and the human can monitor a replay of video transmission in a live event .

Further for claim 37, Yamamura further teaches that command information is detected in a closed caption transmission since it is known that the vertical blanking intervals of the video signal is used for carrying closed caption .

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Applicant argues that "Claim 32 calls for monitoring an ongoing video transmission of a characteristic indicative of a replay, and upon detecting the characteristic, automatically recording the video transmission. Claim 36 calls for a second device coupled to a first device to detect a replay, and a video recorder that automatically records the video signal. in response to the detection of the replay. Yamamura has no teachings regarding replays.

With respect to claim 36, Yamamura employs humans to view footage from the field. Thus, there is no device to detect a replay. Further, the Examiner indicates that the transmission of video that has been reproduced from a recording, medium is a replay. Even so, there is no disclosure in Yamamura of monitoring the video transmission for a characteristic indicative of a replay or detecting a replay and automatically recording the replay upon detection. For example, there is no teaching in Yamamura of an indicator that the footage has been prerecorded. Likewise, there is no teaching in Yamamura that merely because footage has been prerecorded it will be automatically rerecorded. Thus, Yamamura does not teach monitoring for a characteristic indicative of a replay or detection of a replay and automatically recording in response to or upon the detection of a replay."

In response, the examiner disagrees . It is noted that Yamamura employs humans to view footage from the field. Therefore the human can monitor a replay in either a live event or replay of prerecorded recorded event and control a control means for generating a record command signal to indicate a replay . Further Yamamura teaches that the receiver apparatus having a means for detecting the

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recording command signal transmitted together with the video transmission of the replay and generating a control signal to control a recorder to record the video transmission signal .

6. Claims 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated Akira (JP 61-017241 A).

Regarding claims 28-30 , Akira discloses a method comprising: transmitting a video transmission together with a coded command to begin recording of the video transmission (Abstract, Figs. 1-2).

Applicant argues that Akira does not teach that the command coded is transmitted together with the video transmission . In response, the examiner disagrees. It is noted that at figure 2, Akira teaches a start record command and end recording command are transmitted at the beginning of the selected video transmission and at the end of the selected video transmission. It is clear that Akira teaches the record command is transmitted together with the video transmission or insert in the video transmission.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

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subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 11-15 and 20-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo (5,485,219) in view of Camras (4,097,893).

Regarding claims 11-12, 14-15 and 28-38, Woo discloses a transmitter (Fig. 1) and a receiver, the transmitter comprising: a monitor that monitors an ongoing video transmission and provides an indication when a characteristic is detected; and a transmission device that transmits said video transmission together with said indication, wherein said transmission device is an over the air broadcast television transmitter (Fig. 1, Abstract) or cable television transmitter transmission (column 3, lines 30-35, line 41 to column 4, line 15) and the receiver comprises a medium for storing instructions that cause a computer to monitor an ongoing video transmission for a predetermined characteristic; and upon detecting said characteristic, automatically record said video transmission by a recorder while said video transmission is being displayed (column 5,

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line 27 to column 8, line 17, columns 10 and 11).

Further, it is noted that the ongoing video transmission is monitored by a operator when a replay occurred the operator will operate the system to generated a start recording command to control a recorder to record a replay.

Woo fails to specifically teaches that the recording command is transmitted together with video transmission. However, it is noted that transmitting a start command signal together with a video transmission is well known in the art as taught by Camras. Camras at column 3, lines 30-35 teaches means for generating a command signal to start recording of a recorder, the recording command signal can be transmitted separate from video transmission or together with the video transmission .. It would have been obvious to one of ordinary skill in the art to modify Woo with Camas by using a inserting means as taught by Comas for transmission the recording command along with the video transmission by inserting the recording command in a vertical blanking intervals that use for carrying closed captioned of the video transmission, as an alternative method for transmitting the recording command signal of Woo, for transmitting the recording command along with the video transmission.

Regarding claim 13, Woo fails to specifically teach that the video transmission is from a satellite transmitter. However, it is noted that using a satellite transmitter for transmitting video signal is well known in the art Therefore, official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Woo by using a satellite transmitter for transmitting video transmission.

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Applicant argues that "However, the Examiner states that transmitting a start command signal together with a video transmission is well known in the art (see Camras) and it would have been obvious to modify Woo with Camras by using an inserting means as taught by Camras for transmission the recording command along with the video transmission. Id. It is respectfully submitted that by making the suggested modification, **the principle under which Woo operates would be destroyed**. When the proposed modification of the prior art changes the principle of operation of the prior art reference, then the teachings are not sufficient to render the claims prima facie obvious. M.P.E.P. § 2143.02 citing In re Ratti, 123 USPQ 349 (CCPA 1959).

Pursuant to Woo, television transmitters 110 transmit different television broadcasts on different channels. The broadcasts are simultaneously received by the control station 120 and recording devices 190. See Figure 1. A plurality of human monitors at the control station 120 watch the television programs to screen for undesirable content such as commercials. When a commercial is detected, a switch may be actuated to indicate that the recording of a program should be stopped. When the commercial break is over, the operator actuates a switch to indicate that recording should begin again. Thus, the control station 120 simply sends a signal, absent the television broadcast, to the units 180. See Woo at column 3, lines 19-27; 34-37; Figure 1. To do what the Examiner suggests would alter the principle under which Woo operates i.e. the transmission of the broadcast to both the control station 120 and the recording units 190 at the same time. **More specifically, the proposed modification would alter providing a service separate and apart from the broadcast program** ". As such, a prima facie

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case of obviousness has not been established. It is respectfully requested that the section 103 rejection be reconsidered and withdrawn."

In response, it is noted that the modification of inserting the command in the video transmission is also suggested by Woo at column 9 ,lines 5-60). Therefor the combination of Woo and Camas would not destroy the principle of operating of Woo.

Applicant argues that "Claim 32 calls for monitoring an ongoing video transmission for a characteristic indicative of a replay, and upon detecting the characteristic automatically recording the video transmission. Claim 36 calls for a second device coupled to a first device to detect a replay, and a video recorder that automatically records the video signal in response to the detection of the replay. The Examiner concludes that the human operator in Woo would operate the system to generate a start recording command to control a recorder to record a replay. It is respectfully submitted that there is no support for this conclusion. Woo is directed toward recording of a program in its entirety without respect to replays. There is no suggestion that the operator specifically monitors a program for replays and upon detection of the replay automatically records the video transmission. Further, with respect to claim 36, there is no teaching in Woo of a device to detect a replay. Thus, reconsideration of the rejections is respectfully requested."

In response it is noted that Woo teaches that a video transmission is monitored by a operator and the operator can issue commands to recorded or stop a selected a part of video transmission . Therefore , it would have been obvious to one of ordinary skill in the art to use the apparatus and teaching of Woo for monitoring a replay of a

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video transmission and issues control commands for recording a replay of the video transmission since it merely called for an alternative of selecting a desired portion of a video transmission to be recorded.

9. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel in view of official notice .

Regarding claims 12-14 , Vogel fails to specifically teaches that the transmitter is a television cable or a satellite transmitter for off air transmission. However, it is noted that using transmitter as a television cable or satellite transmitter is well known in the art. Therefore official notice is taken and it would have been obvious to one of ordinary skill in the art to modify Vogel by using a television cable or satellite transmitter for transmitting the video transmission.

Regarding claim 15, Vogel teaches the indication is inserted into a vertical blanking interval

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 2600 TECH CENTER customer service whose telephone number is (703) 306-0377.


HUY T. NGUYEN
PRIMARY EXAMINER

H.N

July 26, 2003